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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,461	03/24/2000	Amir Abolfathi	09943-100001	3302

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JAMES M. HESLIN, EQS.
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/534,461

Applicant(s)

ABOLFATHI ET AL.

Examiner

Vanel Frenel

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed ~~response~~ new claims a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-24.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Continuation of 5:

Applicant's arguments and response filed 06/02/03 have been considered but do not overcome the rejection for at least the following reasons:

(A) At pages 3-5 of the 06/02/03, Applicant argues that Andreiko fails to teach a network to communicate manipulable three-dimensional (3D) models. Further, Andreiko fails to teach a storage device and there is no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Andreiko et al.

In response, it is respectfully submitted that perhaps Applicant attributes features or advantages to his purported invention that neither recited or clearly set forth in the claims as presently recited. In particular, Andreiko suggests that "the transmitted information 16 is preferably transmitted from the orthodontist's office 11 to the appliance facility 13 by modem, but may be transmitted in any other manner" which correspond to Applicant claimed feature (See Andreiko, Col.13, lines 44-53). The Examiner respectfully submits that the mere presence of two separate computers that communicate with each other broadly reads on a "network". Further, since Applicant fails to point to any specific definition of "server" within the originally filed specification, it is respectfully submitted that at least one of the computers within the Andreiko system functions as a server in that it handles the administrative control of all or part of the interconnected computers (e.g., "network") of the Andreiko system. Therefore, it is respectfully submitted that Applicant fails to appreciate the vast breadth of the claims, as presently recited.

In response to the second argument, Examiner respectfully submitted that Andreiko suggests "other parameters that are amenable to manipulation with a simple and reliable algorithm in calculating the finish positions of the teeth" which correspond to Applicant claimed feature (See Andreiko, Col.4, lines 38-67 to Col.5, line 18). As such, Applicant fails to properly consider the clear and unmistakable teaching of the applied reference.

In response to the third argument, Examiner respectfully submitted that this limitation has already been addressed in the previous Office Action (Paper number 11).

In light of the above, The Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Thus, the fact situations provided by the Examiner, no matter how infrequent or occasional they may be, are indeed embodiments that Applicant is expected to have considered. As such, since Applicant fails to expressly recite limitations that provide a patentable distinction over such fact situations, it is respectfully submitted that prior art either reads on or makes obvious Applicant's claimed limitations.

(B) At page 5 of the 06/02/03 response, Applicant alleges that there is no motivation to modify the reference teaching so as provide interpolating positional differences to produce intermediate digital data sets of tooth arrangements as presently claimed.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art by expressly pointing to specific portions of each applied reference and has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention (See Paper numbers 7 and 11).

(C) Applicant's remaining arguments rely upon those arguments addressed above, and are likewise moot for the reasons set forth in the preceding responses.